

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1-5, 7, 9-13, 15, 17-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,790,213 to Cherok et al. in view of U.S. Patent Publication 2001/0055622 to Burrell et al.

As to claim 1, 9, 17 Cherok discloses a surgical implant for preventing tissue-tissue adhesion having a least one bioresorbable film layer (36), and a stabilizing mesh (22a) (col. 4. ll. 27-55, col. 6 ll. 40-67, figure 3), but lacks the metallic coating.

Burrell teaches an antimicrobial continuous metallic coating used for hernia meshes (paragraph 19, 20, 50). The summary says the coating can be continuous or in paragraph 57, the coating can be continuous because its

continuous on one side. Additionally, the coating will be in contact with the environment. It would have been obvious to one of ordinary skill of the art at the time of the invention to coat the mesh of Cherok as taught by Burrell in order to make the mesh stronger and/or to control possible infection.

As to claim 2, 3, 10, 11, 18, 19, with the device of Cherok and Burrell, Burrell discloses it can be a titanium alloy (paragraph 72) and the thickness is preferably 500nm (paragraph 20), but lacks the compound in the desirable range. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the of a certain $Ti_aO_bC_c$ formula, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

As to claim 4, 5, 12, 13, 20 with the device of Cherok and Burrell, Cherok discloses the mesh consists of polypropylene (col. 4 ll. 63) but lacks the film layer being polylactate. It would have been obvious to one of ordinary skill of the art at the time of the invention was made to use a polylactate film since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin* 125 USPQ 416.

As to claims 7, 15, Cherok and Burrell, Cherok discloses knotted filaments to attach the film and mesh together (38 figure 7a) that will be coated.

4. Claims 6, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,790,213 to Cherek et al. in view of U.S. Patent Publication 2001/0055622 to Burrell et al. further in view of U.S. Patent 5,593,441 to Lichtenstein et al.

As to claims 6, 14, Cherek and Burrell disclose the device above in claim 1, 9, but is silent about glued spots.

Lichtenstein teaches the glued spots (16) to connect the film to the hernia mesh (figure 1b). Therefore it would have been obvious to one of ordinary skill of the art at the time of the invention to modify how the film is attached to the mesh by using the glue spots of Lichtenstein in order to connect the film and mesh with a stronger connection.

5. Claims 8, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,790,213 to Cherek et al. in view of U.S. Patent Publication 2001/0055622 to Burrell et al. further in view of U.S. Patent 6,319,264 to Tormala et al.

As to claims 8, 16, Cherek and Burrell discloses the device above in claim 1, 9, but is silent about the hemostatic component.

Tormala teaches an agent released coating on a mesh in order to promote healing (col. 3 ll. 51-58). It would have been obvious to one of ordinary skill of the art at the time of the invention to use an additional agent released coating in order to promote healing and allow a more efficient healing process.

Response to Arguments

6. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER ORKIN whose telephone number is (571)270-7412. The examiner can normally be reached on Monday-Friday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. O./
Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/
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